

1 **REMARKS**

2 Applicant respectfully requests allowance of the subject Application. This
3 communication is believed to be fully responsive to all issues raised in the 1/09/06
4 Office Action.

5 Applicant notes that a telephone conversation occurred between Applicant's
6 Attorney and Examiner Harper on 2/2/06 in which the Examiner indicated that
7 upon further review claims 21 and 23 recite allowable subject matter. Applicant
8 appreciates the Office's indication of allowable subject matter.

9
10 **Rejections**

11 **§103**

12 Claims 1, 2, 11, 12, 19-33, and 41-71 are rejected under §103(a) as being
13 unpatentable over U.S. Patent Publication No. 2003/0233349 to Stern et al
14 (hereinafter "Stern") in view of U.S. Patent Publication No. 2003/0195863 to
15 Marsh (hereinafter "Marsh").

16 Claims 3 and 5-10 are rejected under §103(a) as being unpatentable over
17 U.S. Patent Publication No. 2003/0233349 to Stern et al (hereinafter "Stern") in
18 view of U.S. Patent Publication No. 2003/0195863 to Marsh (hereinafter "Marsh")
19 and further in view of Music Match User Guide.

20 Claim 4 is rejected under §103(a) as being unpatentable over U.S. Patent
21 Publication No. 2003/0233349 to Stern et al (hereinafter "Stern") in view of U.S.
22 Patent Publication No. 2003/0195863 to Marsh (hereinafter "Marsh") and further
23 in view of Softpointer.com.

24 Claims 13-18 are rejected under §103(a) as being unpatentable over U.S.
25 Patent Publication No. 2003/0233349 to Stern et al (hereinafter "Stern") in view of

1 U.S. Patent Publication No. 2003/0195863 to Marsh (hereinafter "Marsh") and
2 further in view of Music Match User Guide and further in view of U.S. Patent
3 Publication No. 2004/0175159 to Oetzel.

4 Claims 34-40 are rejected under §103(a) as being unpatentable over U.S.
5 Patent Publication No. 2003/0233349 to Stern et al (hereinafter "Stern") in view of
6 U.S. Patent Publication No. 2003/0195863 to Marsh (hereinafter "Marsh") and
7 further in view of U.S. Patent Publication No. 2004/0175159 to Oetzel.

8
9 Applicant respectfully notes that both Stern and Marsh fall under the
10 §103(c) exception and are disqualified as prior art. Accordingly, neither Stern nor
11 Marsh can be utilized as a basis for rejecting claims of the present application.

12 Stern is a Patent Publication filed on June 14th, 2002 and published on
13 December 18th, 2003. Marsh is a Patent Publication filed April 16th, 2002 and
14 published on October 16th, 2003. The present application was filed on June 26th,
15 2003, which is prior to the publication of either Stern or Marsh. Accordingly, if
16 Stern and Marsh constitute prior art relative to the present application it must be
17 under §102(e) which states:

18 (e) the invention was described in - (1) an application for patent,
19 published under section 122(b), by another filed in the United States before
20 the invention by the applicant for patent or

21 The Office makes a §103(a) rejection based upon Stern and Marsh,
22 however, the Office apparently overlooked §103(c) which states:

23
24 (c)

25 (1) Subject matter developed by another person, which qualifies as
prior art only under one or more of subsections (e), (f), and (g) of section

1 102 of this title, shall not preclude patentability under this section where the
2 subject matter and the claimed invention were, at the time the claimed
3 invention was made, owned by the same person or subject to an obligation
4 of assignment to the same person.

5 The term common ownership is further defined in MPEP § which states:

6 The term "commonly owned" is intended to mean that the subject
7 matter which would otherwise be prior art to the claimed invention and the
8 claimed invention are entirely or wholly owned by the same person(s) or
9 organization(s)/business entity(ies) at the time the claimed invention was
10 made. If the person(s) or organization(s) owned less than 100 percent of the
11 subject matter which would otherwise be prior art to the claimed invention,
12 or less than 100 percent of the claimed invention, then common ownership
13 would not exist. Common ownership requires that the person(s) or
14 organization(s)/business entity(ies) own 100 percent of the subject matter
15 and 100 percent of the claimed invention.

16 The present Application was and is 100% assigned to Microsoft
17 Corporation. Both Stern and Marsh were subject to an obligation of assignment to
18 Microsoft Corp. of 100% interest at the time of filing of the present application. In
19 support of this position, Applicant includes with this communication, a copy of the
20 Patent Assignment Abstract of Title for Stern and a copy of the Patent Assignment
21 for Marsh. (Applicant can further obtain a copy of Stearn's Patent Assignment
22 should the presently submitted USPTO document be deemed insufficient.) Based
23 on the above provided facts and citations, Applicant respectfully submits that both
24 Stern and Marsh are disqualified as prior art relative to the Present Application.
25 Accordingly, Applicant respectfully requests that the §103 rejection based upon
Stern and Marsh be withdrawn. Applicant respectfully submits that the art of
record fails to teach or suggest the features of claims 1-71.


1 **Conclusion**

2 Applicant submits that the above pending claims are in condition for
3 allowance. Applicant respectfully requests issuance of the present Application.
4 Should any issue remain that prevents immediate issuance of the Application, the
5 Examiner is encouraged to contact the undersigned attorney to discuss the
6 unresolved issue.

7 Respectfully Submitted,

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11 Dated 2-17-06

12 
13 _____
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Patent Assignment Abstract of Title

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Total Assignments: 1

Patent #: NONE

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Inventors: Denise Stern, Melissa A. Bohm, Martina Hiemstra, Umachandra Chikkareddy et al

Title: Media player system

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Conveyance: ASSIGNMENT OF ASSIGNORS' INTEREST (SEE DOCUMENT FOR DETAILS).

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